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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/614,631	07/12/2000	John Dennis Hilgren	163.1382US01	2124
23552	7590	10/27/2005	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			PAK, JOHN D	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/614,631	Applicant(s) HILGREN ET AL.	
	Examiner JOHN PAK	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-9, 31 and 35-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 31, 35-38 and 43-46 is/are allowed.
- 6) ☒ Claim(s) 6-9 and 39-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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This Office action is in reply to applicant's response filed on 8/5/2005.

Claims 1-3, 6-9, 31 and 35-46 are pending in this application. The claims remain unchanged from the previous examination of this application.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 6, 8 and 39-42 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Hei et al. (US 6,024,986) for the reasons of record – see pages 4-5 of the 5/5/2005 Office action.

Applicant's remarks and declaration relative hereto have been given due consideration, but they were deemed unpersuasive.

Applicant argues that Hei et al. do not qualify as prior art under 102(a) or (e). Applicant relies on a 131 declaration by one of the inventors, John Hilgren, to establish that the present invention was invented before the 5/14/1999 filing date of Hei et al.

The Examiner is not persuaded, because the 131 declaration is deficient. The

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following table clarifies what is claimed and what is established by the declaration:

	<u>INDEPENDENT CLAIM 6:</u> equilibrium mixture resulting from --	<u>INDEPENDENT CLAIM 8:</u> composition comprising --	APPLICANT'S DECLARATION EVIDENCE
ACETIC ACID	about 50-60 wt%	about 50-60 wt%	No disclosure of a concentrate or equilibrium mixture of a concentrate in Exhibits A or B. In Exhibit B, Falcon 15 O and Falcon 15 AE do not show the same or similar concentrate concentration of ingredients
OCTANOIC ACID	about 10-20 wt%	about 10-20 wt%	" "
H ₂ O ₂	about 5-15 wt%	about 5-15 wt%	" "
CHELATING AGENT	about 0.3-1 wt%	about 0.3-1 wt%	" "
RATIO	at least 1 pbw peroxyoctanoic acid for each about 5 parts of peroxyacetic acid	at least 1 pbw peroxyoctanoic acid for each about 5 parts of peroxyacetic acid	" "

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Therefore, applicant has failed to provide any evidence to establish a date of invention *for the invention of instant claims 6, 8 and 39-42* that predates the filing date of Hei et al. (5/24/1999).

Consequently, the ground of rejection must be maintained.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hei et al. (US 6,024,986) for the reasons of record – see pages 5-7 of the Office action of the 5/5/2005 Office action.

Applicant's remarks and declaration relative hereto have been given due consideration, but they were deemed unpersuasive.

Applicant argues that Hei et al. do not qualify as prior art under 102(a), (e) or 103(a). Applicant relies on a 131 declaration by one of the inventors, John Hilgren, to establish that the present invention was invented before the 5/14/1999 filing date of Hei et al. The Examiner finds the declaration to be insufficient for the reasons fully set forth above and incorporated herein by reference. Hence, Hei et al. qualify as prior art under

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35 USC 102(a) and (e). Furthermore, applicant's attempt to disqualify Hei et al. as prior art under the provisions of 35 USC 103(c) fails because Hei et al. qualify as prior art not only under 35 USC 102(a) but also under 35 USC 102(a).

For these reasons, this ground of rejection must be maintained. If applicant foresees both of the above grounds of rejections being successfully overcome by a different 131 declaration in a continuation application, applicant should accompany such filings with a terminal disclaimer over U.S. Patent No. 6,024,986 in order to expedite prosecution.

Claims 1-3, 31, 35-38 and 43-46 are allowed. Because all claims cannot be allowed at this time, a search update will have to be conducted at the time of the next Office action. The allowance is therefore subject to a search update.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Gary Kunz, can be reached on **(571)272-0887**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JOHN PAK
PRIMARY EXAMINER
GROUP 1600